

Neifeld Docket No: VISX0011U/US

Application/Patent No: 09/307,988

USPTO CONFIRMATION NO: 5573

File/Issue Date: 5/10/1999

Inventor/title: Telfair/Short Pulse Mid-Infrared Parametric Generator for Surgery

Examiner/ArtUnit: Shay/3739

RESPONSE TO NOTICE OF DEFECTIVE APPEAL BRIEF

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

Sir:

In response to the Notice of Defective Appeal Brief Dated 11/29/2007, please consider the following remarks.

The applicant traverses the requirements in the "Notice of Defective Appeal Brief (41.37)" dated 11/29/2007.

On 11/6/2003, the applicant filed an appeal, including an appeal brief.

The applicant received no communication from the USPTO on this as of 3/16/2007.

On 3/16/2007, the applicant filed a request for status.

On 8/10/2007, the USPTO dated an office communication containing a "Notice of Non-Compliance with 37 CFR 1.192(c)" requiring a substitute appeal brief.

On 9/4/2007, the applicant filed the substitute appeal brief required under 37 CFR 1.192(c) by the 8/10/2007 Notice.

On 11/29/2007, the USPTO dated the subject "Notice of Non-Compliant Appeal Brief (41.37)"

The applicant traverses the requirements in the " "Notice of Defective Appeal Brief (41.37)" dated 11/29/2007 because 41.37 is not applicable to this appeal. This appeal was filed under old rule 1.192, not new rule 41.37. In fact, the examiner's mailing of the prior notice of non compliance with 37 CFR 1.192 admits that 1.192 is the applicable rule. In addition, the requirements of 1.192 and 41.37 are inconsistent so that the applicant cannot comply with both at the same time.

Moreover, the subject notice to the BPAI guidance in question and answer 6, posted at: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/bpai91304.pdf>.

That Q and A states that:

Question 6.

If an appeal brief filed before the effective date of September 13, 2004 fails to comply with the content and format requirements of § 1.192 and the Office mails appellant a Notice that correction is required, would an amended appeal brief filed on or after the effective date be required to be in compliance with § 41.37(c)?

No, an amended appeal brief, based on an appeal brief originally filed prior to September 13, 2004, would be acceptable if it complies with either former

§ 1.192 or § 41.37(c), regardless

of when the Office mailed a Notice requiring correction of the noncompliant appeal brief.

Therefore, the "Notice of Non-Compliant Appeal Brief (41.37)" is improper and the requirements in that Notice should be withdrawn.

11/29/2007 /RichardNeifeld#35,299/

Date Richard A. Neifeld, Ph.D.
 Registration No. 35,299
 Attorney of Record

RAN

Date/Time: November 29, 2007 (12:41pm)

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